Supreme Court, U.S.
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No. 00-500

In The

Supreme Court of the United States

ARTHUR S. KOENIG and MDI LABS, INC.,

Petitioners,

v.

FUGRO-MCCLELLAND (SOUTHWEST), INC. and PHILIP KING,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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2000

QUESTION PRESENTED

1. Did the Court of Appeals for the Federal Circuit err when it construed an express limitation in a patent claim to have the same meaning that the patent applicant stressed in the "prosecution history" of his patent?

PARTIES TO THE PROCEEDING

Fugro-McClelland (Southwest), Inc. has changed its corporate name to Fugro South, Inc. The parent corporations and publicly held companies that own 10% or more of the stock of Respondent Fugro-McClelland (Southwest), Inc. are:

Fugro NV (a Netherlands company traded on the Amsterdam Exchange),

Fugro Consultants International NV,

Fugro (USA) Inc.,

Orguf Holding, Inc., and

Fugro South, Inc. (formerly Fugro-McClelland (Southwest), Inc.).

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BRIEF IN OPPOSITION

Fugro-McClelland (Southwest), Inc. and Philip King (hereinafter "Respondents") request that the Court deny the petition for writ of certiorari in this case. The unpublished Federal Circuit opinion presents no conflict or ruling that could justify the Court's review.

STATEMENT OF THE CASE

Petitioners sued Respondents for patent infringement in 1993. After complete discovery, the magistrate judge construed the claims of the patent and compared them to Respondents' machines. Since the material features of Respondents' machines were not disputed, the case was decided on summary judgment. The magistrate judge concluded that Respondents had not infringed. Petitioners sought review by the district court, and the district court's independent conclusion was the same as the magistrate's. On December 29, 1998, the district court made its summary judgment in favor of Respondents a final judgment.

Petitioners appealed. A three-judge panel of the Court of Appeals for the Federal Circuit reviewed the same materials that the district court had reviewed, namely, the patent's claims, specification, and prosecution history,[1] and again construed the patent's disputed

[1] The record of proceedings in the Patent and Trademark Office is referred to as the "file wrapper," *Autogiro Co. of America v. United States*, 384 F.2d 391, 398 (Ct. Cl. 1967), or alternatively as the "prosecution history," or the "file history." *See, e.g., CAE*

claim limitation. The resulting unpublished opinion affirming the district court (reproduced at Appendix A of Petitioners' Brief) construed the disputed claim limitation to have the same meaning determined by the magistrate judge and by the district court.

SUMMARY OF THE ARGUMENT

Petitioners' reasons for review are not "compelling" as required by Sup. Ct. R. 10. The issue of law at the crux of Petitioners' arguments – whether the prosecution history of a patent may be used to construe a claim limitation – has already been decided affirmatively by the Court. In its nearly twenty years of existence, the Court of Appeals for the Federal Circuit has never strayed from this bedrock claim construction principle, and Petitioners' statement of conflicting decisions is made without any authority in support. In this particular case, five different judges have followed the claim construction principles delineated by this Court, and all of those judges arrived at the same claim construction. Further review would be a waste of time.

Screenplates, Inc. v. Heinrich Fiedler GmbH & Co. KG, 224 F.3d 1308, 1318 (Fed. Cir. 2000)

ARGUMENT

I. This Court Has Already Decided The Legal Issue.

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384 (1996), the Court decided *who* should undertake the "mongrel practice" of construing a patent's claims. 517 U.S. at 378, 116 S. Ct. at 1390. *How* the claim construction is to be accomplished had been decided long before. "It is, of course, well settled that an invention is construed not only in light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office." *Graham v. John Deere Co.*, 383 U.S. 1, 33, 86 S. Ct. 684, 702 (1966) (citations omitted). The claim construction principle recited in *Graham* is almost as old as the patent system itself. *Crawford v. Heysinger*, 123 U.S. 589, 602, 8 S. Ct. 399, 406 (1887) ("The file-wrapper and contents in the matter of the reissue [patent] are part of the evidence in the case, and throw light upon what should be the proper construction of claims 1 and 2.").

The Court has consistently applied the long-standing principle that a patent's prosecution history may supply a special definition to a claim limitation. In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 61 S. Ct. 235 (1940), the Court decided the "question whether, in the light of the patent office history of the . . . patent, . . . the court below, in construing the specifications and claims, erroneously included one element . . . in the patented combination." 311 U.S. at 212, 61 S. Ct. at 236. The Court, relying on the file wrapper history, concluded that the claim limitation at issue in *Schriber-Schroth* had a special meaning *different from* the meaning that would have been determined from "the specifications and claims of the

patent [if it] were to be interpreted without reference to its file wrapper history . . . ." 311 U.S. at 217, 61 S. Ct. at 238. The Court has relied on the prosecution history to find special definitions in other patent cases as well. *See, e.g., Weber Elec. Co. v. E. H. Freeman Elec. Co.*, 256 U.S. 668, 676-78, 41 S. Ct. 600, 603 (1921) (relying on remarks in the "file wrapper" which "require that the expressions in the fourth [patent] claim . . . must be restricted to a . . . " special meaning); *Keystone Driller Co. v. Northwest Eng'g Corp.*, 294 U.S. 42, 46-48, 55 S. Ct. 262, 264 (1935) (relying on remarks in the file wrapper to "hold, in view of the prior art and of the file wrapper, the petitioner is not entitled to a broad reading of the claim" because to do so "would be contrary to the limitation which the Patent Office file wrapper shows the applicant placed upon his asserted invention."); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 440-44, 47 S. Ct. 136, 140-41 (1926) (construing claim limitation whose meaning was "limited by the proceedings in the Patent Office").

II. The Court Of Appeals For The Federal Circuit Has Consistently Relied On A Patent's Prosecution History To Construe Claims.

Many Federal Circuit panels have mandated that patent claims should be construed in light of the prosecution history. *E.g., Desper Products, Inc. v. QSound Labs, Inc.*, 157 F.3d 1325, 1333 (Fed. Cir. 1998) ("To determine the meaning and scope of a claim, we first examine the claim language, the specification, and, if in evidence, the prosecution history.") (citations omitted); *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1453 (Fed. Cir. 1998) ("In

a literal infringement analysis, prosecution history is relevant to claim coverage.") (quoting *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996)); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1476 (Fed. Cir. 1998) ("The proper construction of claims is based upon the claim language, the written description portion of the specification, the prosecution history, and if necessary to aid the court's understanding of the patent, extrinsic evidence."); *Regents of Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1572 (Fed. Cir. 1997); *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1152 (Fed. Cir. 1997). Often, the prosecution history is the critical evidence used to determine the proper claim construction.

> [T]he court may also consider the prosecution history of the patent, if in evidence. . . . This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996) (citations omitted).

Special definitions advanced in the prosecution of a patent are given effect in construing claim limitations. *Amhil Enterprises Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1559 (Fed. Cir. 1996) (construing a claim limitation "substantially" in light of the prosecution history); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir.

1995) (construing a claim limitation "sputter-deposited dielectric" in light of the prosecution history).

III. Petitioners' Authorities Do Not Support The Contention That Special Definitions Must Be Found Only In The Specification.

Petitioners' novel argument that a special definition for a claim limitation must be found *only* in the specification of the patent is not supported by any of the authorities cited in their brief.[2] Petition at 4-5. Petitioners' reliance on *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996), is particularly misplaced. Petition at 4. *Markman* adopted the approach explained in *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384 (Fed. Cir. 1992), which held that "terms in a claim are given their ordinary meaning to one of skill in the art unless it appears from the patent *and file history* that the terms were used differently by the inventors." 952 F.2d at 1387 (emphasis added). Furthermore, Petitioners' narrow quote from *Markman* to avoid interpretation based on prosecution history not only ignores *Intellicall*, it disingenuously ignores the rest of *Markman* that fatally disproves their argument:

> To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the *prosecution history*. . . . To construe claim language, the court should also consider the

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[2] Incredibly, after seven years of litigation, Petitioners urge for the first time that prosecution history is not a proper source for determining the meaning of a claim limitation.

> patent's *prosecution history*, if it is in evidence. . . . This 'undisputed public record' of proceedings in the Patent and Trademark Office is of primary significance in understanding the claims. . . . The court has broad power to look as a matter of law to the *prosecution history* of the patent in order to ascertain the true meaning of language used in the patent claims . . . .

52 F.3d at 979-980 (citations and text omitted) (emphasis added).

Petitioners' reliance on *Markman* is also surprising because the Court's *Markman* decision affirmed a claim construction which had been determined by consulting the prosecution history of the patent in that case. *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1537 (E.D. Pa. 1991), *aff'd*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996) (rejecting patentee's litigation-inspired construction because it was contrary to "the obvious meaning intended by the patentee, determined from the specifications, the drawings *and the file histories* of the . . . patent-in-suit.") (emphasis added).

Of the other five cases cited on page 5 of the Petition, three expressly acknowledge the propriety of relying on the prosecution history to construe claim limitations. *See Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477-78 (Fed. Cir. 1998); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994); *Intellicall*, 952 F.2d at 1388. Neither of Petitioners' two other cases includes any indication that a court may *not* examine the prosecution history to construe a claim limitation – they are merely silent as to that point. *See Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527 (Fed. Cir. 1995); *Beachcombers Int'l, Inc. v. Wildewood Creative*

Prods., Inc., 31 F.3d 1154 (Fed. Cir. 1994). Petitioners have cited no authority to support the unusual notion that it is improper to consider the prosecution history in construing a claim limitation. Therefore, despite Petitioners' statements to the contrary, no conflict exists with the Court's precedent or within the Federal Circuit.[3]

IV. Petitioners Present No Reason To Change The Well-Settled Principles.

Petitioners have not presented a compelling reason to change the law followed in *Markman* and its predecessors. Patentees, like Arthur Koenig in this case, who assert a restricted meaning for a claim limitation to convince the Patent Office to allow the patent, should never be permitted to back away from that restriction and construe the patent more broadly when the patent is asserted against alleged infringers. "Claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers." *Southwall*, 54 F.3d at 1576.

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[3] Furthermore, Petitioners' far-fetched notion that the prosecution history cannot supply a special definition to a claim limitation is not even determinative in this case. Petitioners failed to mention that the definition stressed in the prosecution history was quoted directly *from the specification* of the Koenig patent. *See*, Appendix 1 at App. 2 where "[a]pplicant desires to call attention to the definition *in the specification* of the phrases 'reactive force' and 'positive engagement' . . . " (emphasis added).

V. The Appellate Claim Construction Did Not Cause Any Surprise Or Unfair Prejudice.

Petitioners' last complaint, that they were denied the opportunity to "present evidence and create a fact issue on infringement" because of the appellate court's alleged "new claim construction" is spurious. Petition at 4, 7 (footnotes 3 and 4). The magistrate judge, the district court, and the appellate court adopted the claim construction that Respondents have advanced consistently since 1994. *See* Respondents' 1994 claim construction arguments in Petitioners' Exhibit A at 14 (which Petitioners filed with the Court under seal); the magistrate judge's 1997 claim construction in Exhibit A at 16; the district court's 1998 claim construction in Appendix C at 24a; and the Federal Circuit's year 2000 claim construction in Appendix A at 14a. Petitioners' cry of unfair surprise is incredible in light of six years' and five judges' worth of consistent claim construction in this case.

CONCLUSION

Petitioners have not presented a compelling reason or need to revisit the question of whether the prosecution history of a patent may be consulted for guidance about the meaning of an express limitation in a claim of that patent. The law on this point is well-settled and the courts are not in conflict. The Court need not engage itself in yet another round of the "mongrel practice" of construing patent claims merely because Petitioners are

unhappy with all of the decisions below. The petition should be denied.

Respectfully submitted,

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APPENDIX 1 – PROSECUTION HISTORY – FEBRUARY 5, 1990 SUBMISSION TO THE UNITED STATES PATENT AND TRADEMARK OFFICE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Arthur S. Koenig	§	DOCKET NO.: KOEA, 002 Formerly: M-07033.2
SERIAL NO.: 07/250,371	§	GROUP ART NO.: 221
FILED: September 28, 1988	§	EXAMINER: B. Steinberger
FOR: METHOD AND APPARATUS FOR FORCING A MEMBER THROUGH MATERIALS SUCH AS SOIL AND OBTAINING SAMPLES	§	

* * *

RESPONSE B (REVISED)

The Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant responds to the Office Action of June 1, 1989 in this revised Response B as follows. This revised Response B is intended to substitute for the original

Response B filed on November 1, 1989, and only the amendments set out herein are to be entered in the case. A request for a two month extension of the time to respond in accordance with 37 C.F.R. §1.136(a), and an authorization to charge the Deposit Account of Applicant's Attorney's firm for the required fee, were enclosed with the original Response B.

. . .

REMARKS

. . .

Before discussing the §§102 and 103 rejections, Applicant desires to call attention to the definition in the specification of the phrases "reactive force" and "positive engagement" which appear in the claims. As taught so eloquently in Autogiro Company of America v. U.S. (384 F.2d 391, 397 (Ct. Claims 1967)),

> "an invention exists most importantly as a tangible structure or a series of drawings. A verbal portrayal is usually an afterthought written to satisfy the requirements of patent law. This conversion of machine to words allows for unintended idea gaps which cannot be satisfactorily filled. Often the invention is novel and words do not exist to describe it. * * * To overcome this lag, patent law allows the inventor to be his own lexicographer [citations omitted]."

These definitions, therefore, represent Applicant's attempt to fill these "unintended idea gaps", e.g., they are the words chosen to describe an invention which is novel, and it is believed that reference to them is essential to an understanding of how the claims as filed define an invention which is not anticipated by the cited references.

As stated at page 8, beginning at line 1, "positive engagement" of strata 102 is achieved by the interaction of the collar 200 with a discontinuity, such as the groove 216, in the wall of hole 110 which "prevents axial movement of collar 200 in hole 110 regardless of the direction of the reactive forces applied thereto." That "axial movement" would, of course, be movement along the line of action of a member forcing means such as hydraulic cylinder 326.

The phrase "reactive force" is defined at various places throughout the specification. For instance, at page 11, line 2, it is stated that the collar 200 resists the reactive forces "which cause movement either away from or down into strata 102 when force is applied thereto" by activation of the hydraulic cylinder 326. On that same page, at lines 18-20, it is stated that collar 200 engages the discontinuity, or groove 216, in the wall of hole 110 "to transmit the [reactive] force exerted by the force exerting apparatus to which collar 200 is engaged", and on page 14, lines 9-15, it is pointed out that the mechanism for transmitting the reactive force in the strata 102 "is that of introducing an interference to carry shear forces between

the wall of the hole 110 and collar 200 . . . to cause 'lock up' to be achieved."

. . .

Respectfully submitted,

/s/

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Dated: Feb 2, 1990

. . .